

REMARKS

Reconsideration and allowance of the claims are requested in view of the above claims and the following remarks.

No claims have been amended by this response.

Claims 1, 5, 7-11, and 13-15, are pending in the present application, with Claims 1, 5, 10, and 13 being independent claims.

1. Rejection of Claim 1 under 35 U.S.C. 103(a).

Claim 1 was rejected by the Office Action under 35 U.S.C. 103(a) as being obvious in light of McGonigal. As grounds for the rejection, the Action asserts that it would be obvious to add the signal generator selector switch that is missing from McGonigal, but claimed in the present application.

This rejection is hereby traversed because there would have been no motivation to modify the teaching of McGonigal by adding a switching system as claimed in this application. Also, there are indicia of non-obviousness including a longstanding unmet need, and failure of others in the market place to satisfy that need.

In the U.S. PTO Memorandum of May 3, 2007 from Margaret A. Focarino to the Technology Center Directors, regarding the Supreme Court decision on KSR International v. Teleflex Inc. (U.S. April 30, 2007), it was indicated that for the obviousness issue the Court reaffirmed the Graham factors and required the four factual inquires under Graham, including "(d) evaluating evidence of secondary considerations." See Graham v. John Deere, 383 U.S. 1, 17-18, 148 U.S.P.Q. 459, 467 (1966).

In Graham v. John Deere, the Court describes these considerations by saying "considerations such as commercial success, long felt but unsolved needs, failure of others, etc. . . as indicia of obviousness or non-obviousness, these inquires may have relevance."

1.1 Long Felt Unsolved Need

The present application addresses a long felt but unsolved need to be able to locate a remote control device under different circumstances. According to the claimed invention, a location finder means uses a signal generator selector switch which may be switched between modes (1) to address situations where a flashing light only but no sound may be appropriate, and (2) to address situations where both sound and light as a location indication may be appropriate, and (3) to address situations where only sound and no light may be appropriate. The invention provides a multi-modal location indicator selector switch so that an appropriate mode could be used in each circumstance, where other modes would not be appropriate and be unusable. To state this another way, the present invention is not obvious in light of McGonigal, as evidenced by the fact that McGonigal presented one solution to the problem of finding a lost remote, but did not solve the problem solved here – finding a lost remote under different circumstances (where a light or a sound may be inappropriate). McGonigal evidences the long felt need that was not met by the present invention.

1.2 Failure of Others

An additional Graham v. Deere indicator of non-obviousness is the failure of others to solve the same problem. Here, the problem can be described as that of providing a multi-modal remote control location indicator means, where one mode of location indicator would not be appropriate to be used in all cases. The failure of others to satisfy this condition is a second independent indicator of non-obviousness. Neither the examiner nor the applicant has found any reference or any reference in which others have satisfied this need to provide a selectable choice of appropriate alternative location indicator means.

1.3 Teaches Away

Furthermore, the present invention is not obvious in light of McGonigal, because McGonigal teaches away from Claim 1. This is an additional test of non-obviousness, beyond the Graham indicia.

KSR v. Teleflex, at page 22 of the slip opinion, the Court acknowledges that teaching away is grounds for non-obviousness in light of the particular reference. The Court indicates that a prior art reference teaches away if the invention in the reference is "so flawed that there was no reason to upgrade it . . .", and the Court suggests that a prior art device that has failed in the marketplace and is not found in practice is so flawed, as a failed line of development, and hence teaches away.

McGonigal teaches away from the present invention because McGonigal's claimed invention is not found by the applicant or the examiner in the marketplace. The failure of McGonigal in the marketplace teaches away from applying the invention of McGonigal with further development and modification, with the addition of a location signal selector switch, as in the present application, since the prior art as in McGonigal failed in the marketplace and is hence so flawed as to not be upgraded.

Moreover, McGonigal teaches away from the invention here, which involves a more complicated device than McGonigal describes, with an additional switching system. The prior art reference teaches away from a more complex device such as claimed here.

2. Rejection of Claims 5, 7 to 11, and 13 to 15 under 35 U.S.C. 103(a) (in light of Herz).

Claim 5 is rejected as obvious under 103(a) in light of Herz with the Office Action asserting that it would be obvious to apply the claimed invention to electrical devices such as a radio, personal computer, robot, garage door, MP3 player, and an interactive video game playing device. This rejection is traversed.

First, there would have been no motivation to modify the device described in the reference to produce the claimed invention. Also, as indicated above, factual inquiry is required into the non-obviousness issue, under KSR and under Graham.

2.1 Long Felt Unsolved Need.

The invention of claim 5 of the present application is not obvious in light of Herz as evidenced by the long felt unsolved need to find remote controls for radios, personal computers,

robots, garage doors, MP3 players, and interactive video game playing devices. This is an indicator of non-obviousness. The need to provide a location signal generator for remotes for these devices has existed since these devices and remotes for them have existed, and the need has been unsolved until the conception of the invention of the present application.

If the present claims had been obvious in light of Herz, as the examiner wrongly asserts, then this long felt unsolved need would have been satisfied by Herz or others prior to the present invention, and these others would not have failed to satisfy this need prior to the applicant.

2.2 Failure of Others.

Furthermore, there is a second indicator of non-obviousness regarding these claims, and this is the failure of others to satisfy this need to provide a location signal generator on a remote for a radio, personal computer, robot, garage door, MP3 player, or an interactive game playing device, and no such devices have been found in the prior art by the examiner or applicant.

2.3 Teaches Away

Furthermore, the rejected claims are not obvious in light of Herz, because Herz teaches away from these claims. Teaching away is an additional test of non-obviousness, in addition to the Graham factors, as discussed above.

Herz teaches that the invention of Herz applies to "stereo systems, television receivers, cassette tape decks, video tape decks, compact displays, laser vision displays" (column 1 line 10 through 14) and to audio video devices (column 1 line 47), and to "AV devices such as video cassette recorders, stereo systems and digital versatile disk components" (see column 2, line 63-65) and regarding a "television set" (see column 3, line 42). Hence, Herz teaches that the invention of Herz is primarily applicable to television and related audio video equipment, which primarily represents furniture-like equipment that is largely immobile and is permanently installed in the living room or den or family or entertainment room of a house. This teaches away from applying anything like Herz to the equipment indicated in claim 5 of the present invention, being a radio, personal computer, robot, garage door, MP3 player, and an interactive video game playing device, which are not television equipment and not video equipment, and tend to be

mobile, or in the case of a garage door not entertainment equipment, and not installed inside the den or the living of private residences.

Claim 7 depends from claim 5, which is allowable. Therefore Claim 7 is allowable.

Claims 8 and 9 are also dependent on claim 5, which is allowable and therefore claim 8 and 9 are allowable. Furthermore, Claims 8 and 9 refer to a signal generator selector switch, which is not obvious in light of McGonigal as discussed regarding claim 1 above.

The Office Action rejects claims 10 and 13 for the same reasons as claim 5 above. This is traversed, for the same reasons as claim 5 discussed above.

Claims 11, 14 and 15 are rejected for the same reasons as claims 7 and 8 above. These rejections are traversed for the same reasons as discussed above for claims 7 and 8.

3. Conclusion.

In view of the above, the pending claims clearly recite elements that are not obvious in light of the prior art. Therefore, such claims are allowable for at least this reason. Accordingly, reconsideration and withdrawal of the rejections are requested.

The present application is in condition for allowance and favorable action in the form of a Notice of Allowance is requested. Should the Examiner believe that this application is in condition for disposition other than allowance, the Examiner is invited to contact the undersigned at the telephone number listed below in order to address the Examiner's concerns.

The Commissioner is hereby authorized to charge any additional fees which may be required for this Amendment, or credit any overpayment to deposit account no. 22-0261.

Respectfully submitted,



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